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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,206	06/13/2000	RONG FU WANG	2026-4269US1	1577

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EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 03/04/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/529,206

Applicant(s)

WANG ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,5-8,10-16,26,28,29, and 67-86 is/are pending in the application.

4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5-8,26,28,29 and 67-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The Examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Misook Yu.

**DETAILED ACTION*****Election/Restrictions***

Prosecution history indicates applicant elected group I, claims 1-30 drawn to cancer peptides with species C (SEQ ID NO: 4) with traverse in Paper No. 20. Since applicant did not point out errors in the Restriction Requirement (Paper No. 19), the election was treated as without traverse and claims 3, 5-8, and 26-27 were determined to read on the elected group I with species C and were being examined on merits.

Applicant argues in the amendment (Paper No. 22) that the species election requirement made in the previous Office action (Paper No. 19) is improper because SEQ ID NOs: 34-38 as well as other SEQ ID NOs are either fragments of SEQ ID NO: 4 or derivative of fragments of SEQ ID NO:4 and searching all of the species would not be undue burden on the Office. Applicant also states that this point was not made in the previous Response to Restriction Requirement (Paper No. 20). This argument has been fully considered but not persuasive for reason of record because all of the species have different molecular formulas with different biological activities. The requirement is still deemed proper and is therefore made FINAL.

It is noted that claims 28 and 29 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention in the previous office action because it depended on non-elected invention but the amended claims 28 and 29 are now drawn to cancer peptides from SEQ ID NO:4, therefore the claims are examined on merits. Since applicants elected SEQ ID NO:4 as their elected species and received the Office action on merits based on the election, claims 10-16 drawn to non-elected species remain withdrawn from further consideration.

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This application contains claims 10-16 drawn to an invention nonelected with traverse in Paper No. 20. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 3, 5-8, 10-16, 26, 28, 29, 67-86 are pending and claims 3, 5-8, 26, 28, 29, 67-86 are examined on merits.

### ***Specification***

Objection of the disclosure (see page 53) is withdrawn in view of amendment.

### ***Claim Rejections - 35 USC § 112***

Rejection of claims 3, 5-8, and 26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** in view of amendment.

Rejection of claims 3, 5-8, and 26-27 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO: 4, does not reasonably provide enablement for portions and derivatives of SEQ ID NO: 4. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims **is withdrawn** in view of the amendment.

### ***Claim Rejections - 35 USC § 102***

Claims 3, 5-8, and 26, and 27 **remain rejected** for reason of record under 35 U.S.C. 102(a) as being anticipated by Chen, et al., (1997) and the new claims 69-78, and 86 are also applied to this rejection.

Applicant argues that all of the pending claims have been amended to read on specific parts of SEQ ID NO:4, also argues that Chen et al teach SEQ ID NO:4 but does not teach or suggests the instantly claimed specific parts of SEQ

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ID NO:4 are effective at eliciting a CTL-mediated response. This argument is not persuasive because the instant claims drawn to peptides per se still read on SEQ ID NO:4 taught by Chen et al. The instant claims are drawn to a peptide consisting essentially of parts of SEQ ID NO:4 and the Office interprets as open language, i.e. a peptide comprising the specific part of SEQ ID NO:4. Chen et al teach peptide comprising the specific part of SEQ ID NO:4.

### **NEW GROUNDS OF REJECTION**

#### ***Claim Rejections - 35 USC § 112***

Claims 3, 5-8, 26, 28, 29, 67-86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had **possession** of the claimed invention. The claims are interpreted as drawn to a peptide consisting essentially of amino acids 55-62 of SEQ ID NO:4. Since the specification as originally filed does not communicate that instant invention is a peptide consisting essentially of amino acids 55-62 of SEQ ID NO:4, it is a new matter. Applicant says that support for the amended and/or new claims are found at pages 8, 9, and 12 but the support is not apparent to the Office. Applicant is requested to point out the support that applicant invention is a peptide **consisting essentially of amino acids 55-62 of SEQ ID NO:4**.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu

February 27, 2003

  
SHEELA HUFF  
PRIMARY EXAMINER